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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,544	10/25/2000	Michael L. Beacham	426882000200	2119
26212	7590	09/21/2005	EXAMINER	
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			KYLE, CHARLES R	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/696,544

Applicant(s)

BEACHAM ET AL.

Examiner

Charles Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Note** – Applicants' claims recite elements of "straight through" processing of securities transaction. This limitation is addressed in the rejections below. However, a careful reading of the claimed invention shows that the invention is primarily drawn to areas of project management and system optimization. This is supported by the preponderance of claim limitations related to these areas rather than details of securities transaction processing. The application of art in the rejections below is in accord with these comments.

**Claims 1-4, 11-12, 15-18 and 25-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over *IEEE/EIA 12207.0-1996, Software Life Cycle Processes*, hereinafter, *12207* in view of *Windows DNA for Financial Services*, hereinafter *Microsoft*.

**As to Claim 1**, *12207* discloses the invention substantially as claimed, including in a method of assessing the ability of a system, steps of:

identifying one or more assessment issues and storing of the identified one or more assessment issues in an issue and resolution log (pages 24, 41);

capturing process and technology performance information for the system (pages 24, 41);

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analyzing the process and technology performance information with respect to the one or more assessment issues (pages 36-37);

capturing information regarding the ability of at least one system external to the system, wherein the at least one system external to the system may include an industry-wide system, a business partner system, or a vendor system (pages 10-12);

formulating at least one recommendation for improving process and technology performance for the system and prioritizing the at least one recommendation based on the analysis of the technology and performance information (page 46); and

developing an implementation plan, wherein the implementation plan includes at least one task associated with the at least one recommendation (pages 43-44).

*12207* does not specifically disclose that the project to be analyzed and managed is related to straight through processing of securities transactions. *Microsoft* discloses this concept at pages 20-22. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of *12207* to optimize the straight through processing of securities transactions of *Microsoft* because this would facilitate the development of a system which would efficiently implement the desired goal of expeditious securities transaction processing.

As to the limitations reciting storage on computer readable media of various types of information, Official Notice is taken that such storage was old and well known at the time of the invention. For example, Microsoft Project 98™ utilized such storage. It would have been obvious to one of ordinary skill in the art at the time of the invention to use such storage for the

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information disclosed in *12207* because this would provide secure storage of information readily processed to obtain the project management goals of *12207*.

**Regarding Claim 2**, *12207* discloses assessing progress at pages 43-44, particularly section 7.1.3.4.

**As to Claim 3**, *Microsoft* discloses a plurality of activities to implement straight through processing of securities transactions at page 21, section 7.2. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *12207* to assess the particular activities disclosed by *Microsoft* because this would provide parameters relevant to judging the performance of a straight through processing for securities transactions.

**Regarding Claim 4**, *12207* further discloses:

defining at least one project objective and scope (page 11, 5.1.2.1);

developing a communications strategy (page 23, 5.4.4.2);

creating a work plan (page 23, 5.4.1.1);

recording the status of the at least one project at periodic intervals ((pages 38-39);

updating the issue and resolution log (pages 41-42); and

communicating with key sponsors (pages 38-39).

**Regarding Claims 11 and 12**, *12207* discloses current and future technology improvement effects on project performance at pages 24-26.

**As to Claims 15-18 and 25-26**, see the discussion above and of Claims 15-19 and 25-26.

**Claims 5-7, 13-14, 19-21 and 27-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over *IEEE/EIA 12207.0-1996, Software Life Cycle Processes*, hereinafter, *12207* in view of *Windows DNA for Financial Services*, hereinafter *Microsoft* and further in view of *Project Management, A Systems Approach to Planning Scheduling and Controlling, Fifth Edition*, hereinafter, *Management*.

**As to Claim 5**, *12207* discloses the invention substantially as claimed. See the discussion of Claim 4. *12207* does not specifically disclose the limitation of interviewing key executives during the development of project scope and work for a future system. *Management* discloses this limitation at pages 469-471. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the executive interview technique of *Management* in the project management method of *12207* because this would help define needs, requirements, objectives, success factors and end dates, as set forth by *Management* at page 470.

**As to Claim 6**, *Management* further discloses automation information, aggregate human capital resource information and volume impact information at pages at page 950-961. Determination of critical issues is disclosed particularly at page 960.

**Regarding Claim 7**, it recites obvious and known elements of “as-is” and “to-be” states of business processes in transition.

**Regarding Claim 13**, *12207* further discloses project definition including scope (page 13, 55), approach (page pages 16-21), deliverables (page 30), timing (page 18) and resourcing (pages 10-12). *12207* does not specifically disclose consideration of interdependencies. *Management* discloses this limitation in the same environment of project management as *12207* at pages 653-661. It would have been obvious to one of ordinary skill in the art at the time of the

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invention to modify *12207* to include consideration of the interdependencies of *Management* because this would avoid crisis management situations resulting from schedule conflicts. See *Management* at page 656.

**As to Claim 14,** *Management* discloses cost-benefit analysis at pages 81-85.

**As to Claims 19-21 and 27-28,** see the discussions above and of Claims 5-7 and 13-14.

**Claims 8-10 and 22-24** are rejected under 35 U.S.C. 103(a) as being unpatentable over *IEEE/EIA 12207.0-1996, Software Life Cycle Processes*, hereinafter, *12207* in view of *Windows DNA for Financial Services*, hereinafter *Microsoft* and further in view of *Tivoli a Project Guide for Deploying Tivoli Solutions*,, hereinafter, *Tivoli*.

**As to Claim 8,** *12207* discloses the invention substantially as claimed. See the discussion of Claim 1. *12207* does not specifically disclose consideration of impact from business partners and vendor systems on a project. *Tivoli* discloses this limitation at page 25. It would have been obvious to one of ordinary skill in the art at the time of the invention to include such partner/vendors considerations in the project management method of *12207* because this would account for partner/vendor capabilities and experience in project development.

**As to Claim 9,** *12207* discloses the invention substantially as claimed. See the discussion of Claim 1. *12207* does not specifically disclose consideration of impact from technological elements on a project. *Tivoli* discloses this limitation at page 65-69. It would have been obvious to one of ordinary skill in the art at the time of the invention to include such technology considerations in the project management method of *12207* because this would account for the effects of varying configurations on project results.

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**Regarding Claim 10**, see the discussion of Claims 8 and 9.

**As to Claims 22-24**, see the discussion set forth above and the discussion of Claims 8-10.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kyle whose telephone number is (571) 272-6746. The examiner can normally be reached on 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

crk  
September 15, 2005

Examiner Charles Kyle

